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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,139	12/15/2003	Thomas E. Creamer	BOC9-2003-0085 (456)	3696

40987 7590 06/23/2006

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EXAMINER

BRINEY III, WALTER F

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 06/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/736,139	Applicant(s) CREAMER ET AL.	
	Examiner Walter F. Briney III	Art Unit 2615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 16 May 2006 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- 1. Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.**

Claims 1-15 contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to independent claims 1, 6 and 11, the applicant has currently amended these claims to recite "determining when resumption of service over the Digital Subscriber Line is expected." The applicant avers that these new limitations are supported by paragraph 18 and paragraph 28 of the filed application.

Paragraph 18, however, makes no mention of the limitation. At most, paragraph 18 appears to set forth that the administrative system 125 includes a telephone interface for initiating calls and that it may include software for executing the features set forth within the specification.

Paragraph 28 indicates that the administrative system 125 can call any number associated with the subscriber and that the subscriber can be informed of why the DSL line has failed or is off-line as well as when the DSL line or service is expected to be restored or come back on-line. However, this (even in combination with paragraph 18) clearly fails to expressly establish the act of "determining when resumption of service...is expected." The only way for this section (alone or in combination with paragraph 18) to support the claim is if it suggests that the system inherently performs the "determination."

In contrast, as noted in the Final Rejection filed 24 February 2006, a message to a human conveying when service is expected to be restored is non-functional subject matter. There does not have to be any specific determination steps involved for a human to possibly interpret a received message in the manner claimed. For example, the diagnosis presented by the system of Owens is quite enough to convey to a user with knowledge of DSL systems how long it will take for the DSL to be restored. Presupposing nothing about the technical background of the human involved in the mixture, the mere fact that a system responds to a repair request is a sign of forward progress and that the solution will be solved as soon as possible. Further, the instant invention could simply indicate to a user by phone that their problem is being fixed and

is expected to be solved soon within guidelines set forth external to the system, such as by company guidelines. For example, a prerecorded message stating, "thank you for your patience, we are working to solve your problem as quickly as possible." Clearly such a message would not require any special processing/determination.

In all the cases noted above, the system never expressly determined when resumption of service was expected, i.e. a time period, but it is reasonable that a human would interpret the resulting messages as the claimed message. Therefore, there is no reason to conclude that the claim language is inherently supported by the specification, and as such, the new limitations are directed towards new matter.

All dependent claims are likewise rejected for containing limitations directed towards new matter.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. **Claims 1-3, 5-8, 10-13 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Owens et al. (US Patent Application Publication 2003/0053449).**

Claims 1 is limited to "a method of automatically resolving a Digital Subscriber Line failure." As shown in the Final Rejection filed 24 February 2006, all previous limitations of this claim were obvious in view of Owens. The fact that the new limitation of this claim is directed towards new matter notwithstanding, Owens actually anticipates all limitations. In particular, the diagnosis transmitted to the client in step 446 of figure 4B anticipates "a message informing a subscriber to the DSL of when resumption of

service over the DSL is expected.” This interpretation is in contrast to that presented in the previous rejection, but is made to better account for giving the claim its broadest reasonable interpretation. As noted above under point of rejection (1), the diagnosis is sufficient for informing a subscriber of how long it will take for service to resume its normal operation. Further, the diagnosis is “determined” as claimed in steps 438 and 444. Therefore, Owens makes obvious all limitations of the claim.

Claims 2, 3, 5-8, 10-13 and 15 are rejected for the same reasons set forth above regarding claim 1 as well as the respective reasons set forth in the Final Rejection filed 24 February 2006.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 4, 9 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owens in view of Rango (US Patent 6,788,705).**

Claims 4, 9 and 14 are rejected for the same reasons set forth above regarding claim 1 as well as the respective reasons set forth in the Final Rejection filed 24 February 2006.

Response to Arguments

Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter F. Briney III whose telephone number is 571-272-7513. The examiner can normally be reached on M-F 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on 571-272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

WFB


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SUPERVISORY PATENT EXAMINER